

REMARKS

In order to promote administrative efficiency and better communication, the Examiner is invited to make suggestions at any time during the proceedings, via phone, fax or e-mail, whenever such suggestions are within the Examiner's discretion as an aid to placing the claims in order for allowance in a timely manner. The Examiner's conscientious review of this case is appreciated.

Response to Arguments

Applicant thanks the Examiner for her comments in response to Applicant's arguments. It is regrettable, however, that the Applicant's thoughtful response and arguments apparently have somehow been overlooked, with the exception, at least in part, of the Examiner's "Response to Arguments" section of her official action. Consequently, Applicant considers it more efficient to discuss this section first.

Concerning the Examiner's first comment regarding the inherency of the disclosure in Horwitz, Applicant traverses this argument. In Horwitz, although there is arguably disclosed a "browsing method encoded on a computer-readable medium, for managing Internet research in a research session", there is simply *no automatic association* of navigation with a pre-defined project name. Applicant's invention automatically, without further action from the user, associates navigation with the current project.

Concerning the Examiner's statement that the rejected claims do not have the limitation of a "project", Applicant corrects the Examiner and notes that in all independent claims, the limitation of "project" and/or "project name" is pre-existing to the filing of this amendment. Further, such limitations are not at all found in the preamble of the claims and therefore give life and meaning to such claims. It can only be assumed that the Examiner meant to assert that not all claims include the limitation specifically to a "project". In this case, most claims including claim 1 were so limited. Nevertheless, in deference to the Examiner, Applicant has further amended the independent claims to make this point more clear.

If the Examiner should so advise, Applicant grants the Examiner permission to make an Examiner's amendment to replace occurrences of "project" (but not "project name") with the alternate term --project file—. Perhaps, this way, the claims would more precisely recite the association of the project name with a project file, thereby better responding to the Examiner's concerns.

The below arguments repeat Applicant's prior arguments in so far as it appears that the Examiner has not yet fully considered them.

Examiner's Points 2-4: Rejections §112 of claims: 1-3, 5-15, 18-21, 28-35, 37-51 and 54-61:

The Examiner rejected claims 1-3, 5-15, 18-21, 28-35, 37-51 and 54-61 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as his invention, among other points. Applicant has amended the claims in all areas suggested by the Examiner, to clearly add antecedent basis and to otherwise clarify the claims. It is believed that the above amendments made throughout the claims and in particular where the Examiner has kindly specifically pointed out deficiencies satisfy the Examiner's objections and clarify the claims such that they conform to the patent statute. Acknowledgment of this fact is respectfully requested.

Examiner's Points 5-6: Claim Rejections under 35 USC §102:

The Examiner has rejected claims 1-3, 5-15, 18-21, 28-35, 37-51 and 54-61 under 35 USC §102(e) as being anticipated by Horvitz, US Patent No. 6,067,565 (the '565 patent). Applicant respectfully traverses this rejection.

Applicant submits that the standard for finding anticipation is one of strict identity. In other words, to anticipate under §102, a single prior art reference must disclose all the elements, or disclose their equivalents functioning in the same way as the claimed invention (*Shanklin Corp. v. Springfield Photo Mount Co.*, 187 USPQ 129, 133). Further, "too many structural and operational differences" can negate anticipation within the meaning of §102 (*ibid.*, 134). According to the Federal Circuit, "[a]nticipation requires the disclosure in a single prior art

reference of each element of the claim under consideration.” *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), cites omitted. It is not enough, however, that the reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention “*arranged as in the claim.*” *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), cites omitted. Thus even if the prior art reference includes all the elements that are claimed, if the arrangement of the claimed elements is different from the arrangement of the prior art elements, anticipation will not be present.

Regarding Independent claim 1; failure of express disclosure

As grounds for its rejection of claim 1, the Office cites col. 7, lines 50-67 of the ‘565 reference, contending that therein is disclosed the elements of claim 1, the Examiner further commenting that “accessing a desired web page and web pages listed in bookmark as for Internet research in a research section, wherein navigation on the Internet by a user or users is automatically associated with a pre-defined project name, thus creating an associated research summary of URLs visited.” However, this is merely a recitation of Applicant’s claim 1 and is not the language of the cited passage nor its equivalent.

In response, Applicant submits that the ‘565 reference does not disclose each element of the claimed invention functioning in the same way as in the claim as required by the Federal Circuit under *Shanklin Corp.* The language in the body of independent claim 1 clearly recites elements that are not disclosed in the ‘565 reference. Specifically, claim 1 recites the elements of:

A browsing method encoded on a computer-readable medium, for managing Internet research in a research session, wherein the method includes the steps of selecting a pre-defined project name of a current project to which Internet navigation is to be associated, accessing URLs on the Internet for navigation thereon by a user or users, and automatically associating each URL accessed with the project name so as to create an associated research summary of URLs visited.

These limitations do not appear in the passage cited by the Office, and in fact do not appear in the cited prior art reference at all. The cited reference at best can support a contention that the user is able to use a history list to guide his Internet research. However, nothing is said about how this history list is created, other than in the usual manner, which is automatically by mere (and not-necessarily directed) browsing.

"Selecting a pre-defined project name of a current project to which Internet navigation is to be associated" is a key element of the invention in that the invention enables *project-based* or focused browsing. This recitation is a real and meaningful limitation of the claims. It is believed that claim 1 defines a patentable invention under the Statute and that the Examiner may now pass claim 1 to allowance.

Regarding claim 2: failure of express disclosure

As grounds for its rejection of claim 2, the Office cites col. 40, lines 23-26 of the '565 reference, contending that therein is disclosed the elements of claim 2, specifically "incidences of on-line activity being attributed to the project name in the associated research summary". However, Applicant fails to find any mention of project and the passage seems only to refer to conventional use of a favorites icon. It is believed therefore that claim 2 adequately distinguishes the invention over the prior art in that it discloses the "step of attributing incidences of on-line activity to the project name in the associated research summary". The cited references teaches no such step. It is believed that claim 2, as well as claims 12, 13, 14, 15, 18, 19, 20, 39 require an "attribution", and thus define a patentable invention under the Statute. Consequently, the Examiner may now pass these claims on to allowance.

Regarding claims 3, 5-15, 18-21, 31, 34-35, 37-51, and 55

As grounds for its rejection of claim 3, 5-15, 18-21, 31, 34-35, 37-51, and 55, the Office cites various sections of the '565 reference. Unless the Applicant specifically addresses these assertions hereinbelow, he asserts that these claims are dependent on patentable base claim 1 and

therefore, they themselves are also patentable for the same reasons as such base claim. It is believed that these claims 3, 5-15, 18-2131, 34-35, 37-51 and 55 define a patentable invention under the Statute and that the Examiner may now properly pass these claims on to allowance.

Regarding claim 28-30: failure of express disclosure

As grounds for its rejection of claim 28, the Office cites col. 1, lines 12-20 of the '565 reference, contending that therein is disclosed the elements of claim 28. However, this is merely a recitation of Applicant's claim 28 and is not the language of the cited passage nor its equivalent. In response, Applicant submits that the '565 reference does not disclose each element of the claimed invention functioning in the same way as in the claim as required by the Federal Circuit under *Shanklin Corp.* The language in the body of independent claim 28 clearly recites elements that are not disclosed in the '565 reference. Specifically, claim 28 recites the elements of:

A system for performing research, the system comprising a computer and storage media encoded with a method which, when researching an internet, and upon input by a user of a project name, associates contiguous online time with the project name, wherein URLs of web sites which the user downloads for viewing are recorded in a record in association with the project name.

However, Applicant fails to find any mention of "project" and the passage seems only to refer to a method dealing with a "user". Any browsing method must have a "user" involved -- this is nothing new. In Applicant's invention, another convention is added, namely that of defining a research session according to a "project" and automatically associating sites visited to this *project*. It is believed therefore that claim 28, and claims 29 and 30 which depend therefrom, adequately distinguish the invention over the prior art in that it requires "the input by a user of a project name, associates contiguous online time with the project name", such element being completely lacking in the cited reference. It is believed therefore that claim 28, as well as claims 29-30 which are dependent therefrom, define a patentable invention under the Statute and that the Examiner

may now properly pass these claims on to allowance.

Concerning claim 31, failure of express disclosure:

Claim 31 has been amended so as to be dependent on claim 1. Therefore, for the same reasons that claim 1 defines a patentable invention, so too does claim 31. However, claim 31 includes the further limitation of the "step of presenting input means for inputting comments on URLs visited, any comments entered being stored locally in association with the URL so as to allow the stored information and associated URL to be available for key-word searching when the user is not connected to the Internet". Therefore, the claim further distinguishes the invention over the prior art and consequently, the Examiner may now properly pass the claim on to allowance. Acknowledgement of this fact is respectfully requested.

Concerning claim 32-33, failure of express disclosure:

As grounds for its rejection of claim 32, the Office cites col. 7, lines 50-67 of the '565 reference, contending that therein is disclosed the elements of claim 32. However, this is merely a recitation of Applicant's claim 32 and is not the language of the cited passage nor its equivalent. In response, Applicant submits that the '565 reference does not disclose each element of the claimed invention functioning in the same way as in the claim as required by the Federal Circuit under *Shanklin Corp.* The language in the body of independent claim 32 clearly recites elements that are not disclosed in the '565 reference. Specifically, claim 28 recites that "wherein, after a user activates the link, input reception means is presented to the user, said means providing for the input of alphanumeric characters identifying a project to which at least a navigation history of the research session is to be associated, or for confirmation of association with a project identified by alphanumeric characters already input, and when such characters are received or an association with the already input characters is confirmed, the method downloads the requested information in association with the selected alphanumeric characters." Again, Applicant fails to find any mention of "project" and the passage seems only to refer to a method dealing with a "user". In Applicant's invention, another convention is added, namely that of defining a research session

according to another criteria beyond that of a user, namely a "project" and automatically associating sites visited to this *project*. It is believed therefore that claim 32, and claims 33 which depends therefrom, adequately distinguish the invention over the prior art. Consequently, claims 32 and 33 define a patentable invention under the Statute and that the Examiner may now properly pass these claims on to allowance.

Concerning claim 33, the Examiner cites Col. 4, lines 61-65 of Horvitz. However, Applicant can find nothing in Horvitz that teaches or remotely suggests the element of comparing the root URLs to determine whether or not the activated link is potentially relevant or not. It is therefore asserted that claim 33 further patentably distinguishes the invention from the '565 reference. Claim 33 can properly be passed on to allowance.

Concerning Claim 54: failure of express disclosure:

As grounds for its rejection of claim 54, the Office cites col. 2, lines 60-67 of the '565 reference, contending that therein is disclosed the elements of claim 54. However, this is merely a recitation of Applicant's claim 54 and is not the language of the cited passage nor its equivalent. In response, Applicant submits that the '565 reference does not disclose each element of the claimed invention functioning in the same way as in the claim as required by *Shanklin Corp.* The language in the body of independent claim 54 clearly recites elements that are not disclosed in the '565 reference. Specifically, claim 54 recites: that an "ordinary user is required to input a project name for association with the user's research, and if such research is identified as being of a personal nature, an access control matrix limits access by the user using the project having a personal name to the Internet for such research to substantially non-work hours." Applicant finds nothing in the '565 patent that teaches or remotely suggests this. In Applicant's view, the section of the '565 patent cited by the examiner can at best stand for a method of identifying pages linked to on a downloaded page for relevance to the interests of the user. There is nothing project based about this. Further, no matrix at all is disclosed that determines the permissions of a user to access the Internet depending on the nature of the research. It is believed therefore that the claim is completely different from that disclosed in the '565 patent. Consequently, the Examiner may

now properly pass the claim on to issuance.

Concerning claim 56-58, failure of express disclosure:

As grounds for its rejection of claim 56, the Office cites col. 7, lines 35-67 of the '565 reference, contending that therein is disclosed the elements of claim 56. However, this is merely a recitation of Applicant's claim 56 and is not the language of the cited passage nor its equivalent. In response, Applicant submits that the '565 reference does not disclose each element of the claimed invention functioning in the same way as in the claim as required by the Federal Circuit under *Shanklin Corp.* The language in the body of independent claim 56 clearly recites elements that are not disclosed in the '565 reference. Specifically, claim 56 recites that "upon the input of a project name, the method includes the step of associating contiguous online time with the pre-selected project name, wherein the URLs of web sites which the user downloads for viewing will be recorded in a record on the computer in association with the project name." No such element exists in the referenced section. It is believed therefore that the Examiner can now properly pass claim 56, as well as those claims dependent therefrom (claims 57-58) on to issue.

Concerning claim 59-61, failure of express disclosure:

As grounds for its rejection of claim 59, the Office cites col. 7, lines 50-67 of the '565 reference, contending that therein is disclosed the elements of claim 59. However, this is merely a recitation of Applicant's claim 59 and is not the language of the cited passage nor its equivalent. In response, Applicant submits that the '565 reference does not disclose each element of the claimed invention functioning in the same way as in the claim as required by *Shanklin Corp.* The language in the body of independent claim 59 clearly recites elements that are not disclosed in the '565 reference. Specifically, claim 59 recites that "navigation on an internet by a user or users comprises automatic association of URLs that are accessed with a pre-defined project name and wherein information in respect to selected of said accessed URLs is able to be stored in a computer storage medium, said information comprising the URL address and a reference to a project name." There are no discussions of "project names" in the Horwitz disclosure. This

element is thus missing from the '565 reference. Consequently, the Examiner may now properly pass claim 59, and claims 60-61 which depend therefrom, on to issue. Acknowledgement of this fact is respectfully requested.

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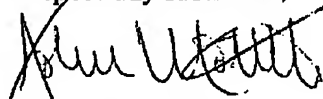
Conclusion

Applicant has made a diligent effort to advance the prosecution of this application by amending claims, and by pointing out herein with particularity how the claims now presented are patentably distinct from the prior art of record. Therefore, Applicant respectfully submits that the claims, as amended, are now in condition for allowance. No new matter has been entered by this amendment. Any limitations to the claims are made solely for the purpose of expediting the prosecution of the application and, unless otherwise expressly stated, are not made to narrow, vis-à-vis the prior art, the scope of protection which any subsequently issuing patent might afford. Again, if the Examiner has further questions, she is invited to contact the undersigned at phone 011-4171-230-1000, fax at 011-4171-230-1001 (Switzerland is 6 hours ahead of Eastern Std Time), or e-mail at moeteli@patentinfo.net.

Applicant petitions the Commissioner for an Extension of Time under 37 CFR §1.136 for a period of X month and authorizes the Commissioner to charge any fee or credit any overpayment of any fee under 37 CFR §1.16 and §1.17 which may be required in this application to the deposit account of MOETTELI & ASSOCIES SARL, no. 50-2621.

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Respectfully submitted,



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Enclosure: Notice of Appeal